

REMARKS/ARGUMENTS

Status of the Claims

In the Office Action mailed March 11, 2005 claims 1, 3-9 and 11-21 are pending. Claims 1, 3-9, and 11-21 were rejected. This rejection is respectfully traversed. Claims 8, 13 and 20 have been amended. No new matter has been added. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Claim Rejections 35 U.S.C. §112

Examiner rejected claims 8 and 13-19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Without conceding the propriety of the rejection, but rather to further prosecution of this case, Applicant has amended claims 8 and 13 which obviates this rejection. In light of the amendment to the claims, Applicant hereby respectfully requests that the rejection to these claims be withdrawn and the claims allowed.

Claim Rejections 35 U.S.C. §103(a)

Examiner rejected claims 1, 3-7, 9, 11 and 13-21 under 35 U.S.C. §103(a) as being obvious over Coile, *et al.*, (hereinafter "Coile"), in view of Pedersen. The rejection is respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. In light of the following arguments, the combined references do not teach or suggest all of the claim limitations of the present invention. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970).

Claims 1, 13 and 21

Coile discloses a server system having a primary and secondary server that are self monitoring and are configured using a special “failover cable”. See, Abstract and col. 9, line 23+. Applicant respectfully points the Examiner’s attention to col. 9, lines 23-28 which state “[o]nce in a failed state . . . a transition is not made back to the the normal state unless the power is cycled on the local network device.” {bolded emphasis added}. Thus, booting the first server requires an active action of turning the power back on. Next, Coile states “[w]hen powered up, each network device may be in the primary state, depending on which end of the failover cable is connected to the network device.” {bolded emphasis added} (Col. 8, lines 37-39). Accordingly, the Coile system’s configuration is a function of a hardware setup, i.e., the state of the system’s **failover cable**. Coile does not teach or suggest a method for

providing backup server support, that includes performing a step of booting the first server, and in response to the booting of the first server: signaling, using a second signal, the monitor server address, and monitoring for a response to the second signal within a second time period, as recited in claim 1 and similarly in claims 13 and 21, an issue that the Office Action admits on page 5. Thus, Coile does not teach or suggest each and every limitation of independent claims 1, 13 and 21.

Pedersen discloses a system where the load of the servers on a network is determined. Pedersen does not teach or suggest performing a step of booting the first server, and in response to the booting of the first server: signaling, using a second signal, the monitor server address, and monitoring for a response to the second signal within a second time period, as recited in claim 1 and similarly in claims 13 and 21.

To the contrary, Pedersen does not disclose or suggest, or even appreciate, any advantage by which a rebooted server would communicate with a monitor server address to determine configuration. Applicant respectfully asserts that there has been a misreading of Pedersen. Applicant points to the specific language relied upon by the Office Action (col. 5, lines 13-45) reproduced below.

“Periodically, the master network information server node 34 transmits a declare message to the other nodes on the LAN declaring itself to be the master network information server node 34. If another node believes itself to be a master network information server node 34 for the cluster 50, **the other node will request an election.**” {Bolded emphasis added}

Therefore, according to the specific text relied upon by the Office Action, an **election** process is required to perform a system configuration. In reviewing the text above, Applicant points to col. 4, lines 55-60 where the term “**election criteria**” is defined to be “whether or not the node is statically configured as a master network information server node; whether the node

has the higher master network information server software version number; [and] whether the node is an NT domain controller”

The specific election criteria outlined in Pedersen is markedly different from Applicant’s claimed approach, and no way requires, discloses or even appreciates the use of monitoring for a response to a second signal within a second time period for system configuration. Thus Pedersen does not provide for the deficiencies of Coile.

Furthermore, there is no motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill to modify Coile using the teachings of Pedersen. While the Office Action states on page 6 that, “one of ordinary skill in the art would have been motivated to utilize the election mechanism of Pedersen . . . to select a backup server from a group of potential backup servers, in order to ensure that the most capable server is selected to replace the primary server in Coile,” this stated motivation is problematic for a number of reasons.

First, the stated motivation is not found in any reference of record.

Second, the Office Action provides no evidence, other than an unsupported conclusion, that this motivation would be apparent to one of ordinary skill in the art. That is, there is no underlying foundation of fact upon which the assertion is made to modify Coile.

Third, it is not apparent that Coile would benefit from the election mechanism of Pedersen due to the intrinsic nature of Coile’s “failover cable”. That is, to modify Coile as suggested, a critical functionality of Coile’s entire configuration paradigm, i.e., Coile’s failover cable, is rendered ineffective.

Thus, independent claims 1, 13 and 21 are directed to patentable subject matter. Because claims 1, 13 and 20 are in condition for allowance, claims 2-7, 9, 11 and 14-19 are also in condition

for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

Claim 20

For the reasons stated previously, it is respectfully submitted that Coile and Pedersen either separately or in combination, fail to teach or suggest, *inter alia*, “a means for signaling the primary server address; a means for monitoring for a response to the signal within a predetermined time period; and a means for repeating the signaling step and the monitoring step until the response is not received within the predetermined time period; a means for booting the first computing apparatus, and in response to the booting of the first computing apparatus,” as recited in claim 20. Accordingly, withdrawal of the rejection of this claim is respectfully requested.

Claim 8

Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Coile, in view of Pedersen as applied to claim 1 above, and further in view of Midgeley, *et al.* (U.S. Patent No. 5,592,611). Because claim 8 depends from independent claim 1, which is believed to be in condition for allowance, this claim is also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Claim 12

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Coile, in view of Pedersen, as applied to claim 1 above, and further in view of Li, *et al.* (U.S. Patent No.

Application No. 10/022,574
Docket No. 87354.2781

5,473,599). Because claim 12 depends from independent claim 1, which is believed to be in condition for allowance, this claim is also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that this application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at 202-861-1746 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87354.2781.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "Rabiya S. Kader", is written over the printed name.

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